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Supreme Court of the United States.

OCTOBER TERM, 1959.

No. 646.

JAMES MOON, EDMOND M. WAGNER AND PHILIP SUBKOW,
Petitioners,

v.

CABOT SHOPS, INC., AND HOWARD SUPPLY COMPANY,
Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

The petitioners seek by their petition to upset the decision of the United States District Court for the Southern District of California, unreported, and the affirming decision of the Court of Appeals for the Ninth Circuit, reported at 270 F. 2d 539.

This is a patent case which involved conventional issues of validity and infringement. After a full trial the District Court held the patent valid but not infringed, and the Court of Appeals for the Ninth Circuit affirmed on all points. Although petitioners asked this Court to believe that the decision of the Court of Appeals is in conflict with decisions of this Court and with decisions in other Courts of Appeals, the opposite is true.

The center of petitioners' effort seems to lie in the treatment of claim 5 of the Moon patent in suit, and petitioners allege that the Court imported into that claim a limitation not there expressed but contained only in some or all of the other four claims. They also argue that the Court improperly applied the doctrine of file wrapper estoppel.

These arguments can very quickly be disposed of.

As to Claim 5, the Court Found it Specifically Limited to the "Straddling" Feature.

At pages 12 and 13 of the petition is reproduced the discussion by the Court of Appeals of the five claims in the patent. After pointing out that respondents conceded that claim 1 was limited to the straddling feature, the Court quotes language from claims 2 to 5 and comments:

> "It appears from the quoted portions of the claims that the straddling feature found in claim 1 is present in each of them."

We believe it will be obvious from reading claim 5 that it is very clearly and definitely limited to a construction in which the legs of the derrick "straddle" the cab. What other conclusion could be drawn from the terminal portion of that claim, which reads as follows:

> "and said hinge being located with respect to the longitudinal axis of said chassis locating said lower ends of one pair of front and rear legs and their respective cooperating means to one side of said driver's position and the lower ends of the other pair of front and rear legs and their respective cooperating means at the other side of said driver's position with the derrick in said erect position"!

Since the driver sits in the cab, it is perfectly obvious that the quoted structure means that, when the driver is in his position in the cab, he has two legs of the derrick on one side of him and the other two legs on the other side. If that is not "straddling," it is difficult to see what it could mean.

We submit that the Court of Appeals did not import any limitation into claim 5 which is not clearly expressed in the claim itself.

The Court of Appeals Properly Applied the Doctrine of File Wrapper Estoppel.

The file wrapper of the patent in suit makes it abundantly clear that Moon first sought a broad patent covering the general concept of a derrick pivotally mounted at the front end of a chassis. Throughout several years of prosecution before the Patent Office Moon was entirely unable to convince the Examiner that he had an invention of such breadth. Finally, the Examiner specified that he would only allow claims in which the legs of the derrick straddled the cab (see footnote on page 6 of the petition). Moon thereafter acquiesced, and claims 1 to 4 all include the word "straddle," and claim 5 has language to the same effect. Moon gave up claims directed to the general arrangement of a derrick mounted at the front of the chassis and gave up every version of such an arrangement which did not include the straddling of the cab or driver's position by the legs of the derrick. In respondents' construction all four legs of the derrick are clearly out ahead of the cab. To make claim 5 read on respondents' structure requires a recapture of the precise subject matter which was given up in order to avoid the rejection which the Patent Office consistently applied to every claim which did not include the "straddling" limitation.

Conclusion.

This case does not present any novel or substantial issues of law. Petitioners are dissatisfied with the manner in which the courts below interpreted the patent in suit, its file wrapper, and respondents' structure. We respectfully contend that the facts found by the District Court impelled the result both in that Court and in the Court of Appeals. This case does not have the earmarks of one presenting a situation calling for review by the Supreme Court of the United States.

Respectfully submitted,

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